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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,347	01/26/2006	Andreo Larsen	75692/IPW/JW	1671
23432 7590 03/01/2010 COOPER & DUNHAM, LLP 30 Rockefeller Plaza 20th Floor NEW YORK, NY 10112				
EXAMINER ANDERSON, CATHARINE L				
ART UNIT		PAPER NUMBER		
3761				
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03/01/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,347

**Applicant(s)**

LARSEN, ANDREO

**Examiner**

LYNNE ANDERSON

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 3 December 2009 have been fully considered but they are not persuasive.
2. In response to the applicant's argument that the ring of Berg must be formed from a rigid or semi-rigid material, and therefore is not suitable for modification to be formed from a single piece of material and extend over the top of the tip of the sheath, it is noted that Berg does not disclose any rigid material. Berg discloses in column 3, lines 63-66, that the ring 50 is in a substantially flat configuration when removed from the package, as shown in figure 11. The ring 50 is then compressed, as disclosed in column 4, lines 1-2, such that the ring 50 bends to form an opening, as shown in figures 13 and 14. Therefore, the ring of Berg cannot be made from a rigid or semi-rigid material, or it would not be able to function as disclosed by Berg. The ring must be formed from a flexible material to allow the ring to be compressed and opened. Therefore, one of ordinary skill in the art would be capable of modifying the ring of Berg to comprise a single piece of material.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-8 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (4,863,448).
5. With respect to claims 1 and 2, Berg discloses all aspects of the claimed invention with the exception of the rip tag comprising a single piece of material. Berg discloses a sheath 10, as shown in figure 3, containing absorbent material 22, as shown in figure 4. The sheath further comprises fixing strips 52, as shown in figure 14, with adhesive surfaces bent to opposite sides of the sheath, as shown in figure 13. The adhesive is covered by a rip tag 50, as shown in figure 11, which is curved, as shown in figure 14, and therefore is substantially U-shaped. The rip tag is attached to the adhesive at opposite sides (i.e. opposite ends), as shown in figure 14. The rip tag encircles the outer surface of the sheath, as shown in figure 13, and therefore extends around the front side of the sheath. The rip tag is bent inwardly along its top and bottom ends, as shown in figure 14, and engages with the adhesive surface, as shown in figure 13.
6. Forming the rip tag out of a single piece of material, rather than the two connected pieces shown by Berg in figure 14, would provide the predictable result of simplifying the process of manufacturing the sheath, since it would reduce the number of steps required to form the rip tag. It would therefore be obvious to one of ordinary skill in the art at the time of invention to form the rip tag of Berg from a single piece of material to provide the predictable result of simplifying the process of manufacturing.
7. With respect to claims 5 and 14, the rip tag is dimensioned such that a gap forms between the tag and the sheath on both sides of the sheath, as shown in figure 13, and

the gap is fully capable of receiving a user's finger during straightening of the fixing strips.

8. With respect to claims 6, 15, and 16, the rip tag has a protruding gripping point at a central point where the user may grip the tag, as shown in figure 14.

9. With respect to claims 7 and 17, the rip tag extends over and beyond the surface of the adhesive to form a gripping point, as shown in figure 14.

10. With respect to claim 8, the tip of the fixing strips attached to the sheath is not covered by the adhesive coating, and these portions of the fixing strips are fully capable of being pulled during removal of the device.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (4,863,448) in view of Figuerido (5,643,235).

12. Berg discloses all aspects of the claimed invention with the exception of the sheath and fixing strips being formed of a unitary piece of the same material. Berg discloses a sheath for an incontinent male having separate fixing strips attached thereon, as shown in figure 13. Figuerido discloses a sheath for an incontinent male having fixing strips 30 made from an extension of the sheath material, as shown in figure 3. This configuration obviates the need for additional material for forming the fixing strips. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the sheath of Berg with fixing strips that are an extension of the sheath material, as taught by Figuerido, to obviate the need for additional material.

13. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (4,863,448) in view of Smith (4,601,716).

14. Berg disclose all aspects of the claimed invention with the exception of the absorbent material being fibrous. Smith teaches a sheath for an incontinent male including an absorbent material comprising fibrous cotton, as disclosed in column 2, lines 30-32. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the sheath of Berg with a fibrous absorbent material, since Smith teaches the use of fibrous absorbent material as providing a reasonable expectation of success for absorbing urine from an incontinent male.

#### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNNE ANDERSON whose telephone number is (571)272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. A./  
Examiner, Art Unit 3761  
/Tatyana Zalukaeva/  
Supervisory Patent Examiner, Art Unit 3761